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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,465	08/14/2001	Jeff Kirsner	HALB:020	9062

7590 10/04/2002
Karen B. Tripp
Attorney at Law
P.O. Box 1301
Houston, TX 77251-1301

EXAMINER

TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 10/04/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.

①A-6

Office Action Summary

Application No.

929465

Applicant(s)

KIRSNER

Examiner

P. TUCKER

Group Art Unit

1712

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1 - 89 is/are pending in the application.

Of the above claim(s) 59 - 80, 86 - 89 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 - 3, 5 - 58, 81 - 85 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4, 5

☐ Interview Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-58 and 81-85, drawn to drilling fluids comprising esters, classified in class 507, subclass 138.
 - II. Claims 59-80 and 86-89, drawn to drilling fluids comprising hydrocarbons, classified in class 507, subclass 103.
2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different effects upon the environment when used in drilling operations.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Karen Tripp on 9/16/02 a provisional election was made without traverse to prosecute the invention of I, claims 1-58 and 81-85. Affirmation of this election must be made by applicant in replying to this Office action. Claims 59-80 and 86-89 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 39 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants specification fails to teach that the mineral oil comprises less than 1 weight percent aromatics.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claims 42 and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 42, the phrase "similar to" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). It is not clear in what manner such structures are similar.

In claim 50 the term "blend of esters and glyceride triesters" is used. Since glyceride triesters are esters, the scope of the term "ester" in the claim is not clear. May glyceride triesters alone comprise the continuous phase?

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes

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of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

11. Claims 1, 2, 5-9, 12, 13, 14, 18-22, 25, 26, 81 and 82 are rejected under 35 U.S.C. 102(b) as being anticipated by Mueller (5869434).

Mueller teaches a drilling fluid which comprises an ester and linear alpha olefin as continuous phase, wherein the ester may be a product such as PETROFREE, or rapeseed oil. A linear alpha olefin may be produced by isomerization, thus applicants claims do not distinguish absent further definition of the olefin structure. Applicants method of making the ester does not distinguish, since in product by process claims, only the product is examined (In re Thorpe 227 USPQ 964).

12. Claims 50-55, 57, 58 and 85 are rejected under 35 U.S.C. 102(e) as being anticipated by Mueller (6165946).

Mueller teaches a drilling fluid which comprises esters of 2-ethylhexanol alcohols and rapeseed oil (see Example 13). Applicants method of making the ester does not distinguish, since in product by process claims, only the product is examined (In re Thorpe 227 USPQ 964).

13. Claims 1-3, 5-9, 12-22, 25-28, 30-33, 36-38, 43, 44, 48-54, 54, 57, 58, 81-85 are rejected under 35 U.S.C. 102(e) as being anticipated by Patel (US 2001/0009890 A1).

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Patel teaches a drilling fluid which comprises esters and an C16-18 isomerized olefin (see examples). Patel further teaches the combination of various esters and hydrocarbons such as mineral oils (see claims 1 and 9). Such mineral oils would comprise paraffins according to the present invention. Applicants method of making the ester does not distinguish, since in product by process claims, only the product is examined (In re Thorpe 227 USPQ 964).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1, 10, 11, 14, 23, 24, 38-42, 45-47, 50, 54-56, 81, 82, 84, 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel (2001/0009890 A1).

Patel teaches a drilling fluid which comprises esters and an C16-18 isomerized olefin (see examples). Patel further teaches the combination of various esters and hydrocarbons such as mineral oils (see claims 1 and 9). Such mineral oils would comprise paraffins according to the present invention. Patel differs from the present invention in that the use of 2-ethylhexanol is not disclosed, and the specific composition of the mineral is not disclosed. The use of 2-

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ethylhexanol would be obvious to one of ordinary skill in the art given the teaching of Patel that alcohols of C1-12 length may be used in the formation of the Esters (claim 1). Furthermore, the use of low aromatic mineral oils, comprising paraffins and olefins of low carbon chain length in order to protect the environment would be an obvious variation to one of ordinary skill in the art.

16. Claims 27-37 and 83 rejected under 35 U.S.C. 103(a) as being unpatentable over Lin (5569642) in view of Mueller (6165946).

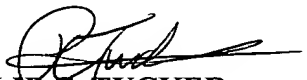
Lin teaches the use of a mixture of linear and branched paraffins for use as the continuous phase of a drilling fluid. Lin teaches that the paraffin mixture may be used in combination with an ester in order to improve the performance of the fluid or lower costs (column 3, lines 39-43). Lin differs from the present invention is not disclosing an example of such esters. Mueller teaches the use of an ester oil in drilling fluids which comprises esters of 2-ethylhexanol (column 22). It would be obvious to one of ordinary skill in the art to use known drilling fluid ester formulations such as that of Mueller, in the drilling fluid of Lin, given the teaching of Lin that esters may be used therein in order to improve drilling performance, or lower cost.

17. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. Is 703-872-9311.

PCT-2647
September 30, 2002


PHILIP C. TUCKER
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